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10/538,730

06/13/2005

Olivier Guerret

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03/26/2008

ARKEMA INC.

PATENT DEPARTMENT - 26TH FLOOR

2000 MARKET STREET

PHILADELPHIA, PA 19103-3222

EXAMINER

BERNSHTEYN, MICHAEL

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|---|--|
| Office Action Summary | Application No. 10/538,730 | Applicant(s) GUERRET, OLIVIER | |
| | Examiner MICHAEL M. BERNSHTEYN | Art Unit 1796 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action follows a response filed on January 4, 2008. Claims 1, 3, 6, 9 and 13 have been amended; no claims have been cancelled; claim 21 have been added.
2. In view of the amendment(s) and remarks, the objection of claims 5, 6 , 9 and 13, and the rejection of clam 3 under 35 U.S.C. 112, 2nd paragraph have been withdrawn.
3. Claims 1-11, 13 and 17-21 are pending.

Claim Rejections - 35 USC § 103

4. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
5. Claims 1-11, 13 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable as obvious over Nesvadba et al. (U.S. Patent 6,262,206), for the rationale recited in paragraph 3 of Office Action dated October 4, 2007, and comments below.
6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable as obvious over Nesvadba et al. (U.S. Patent 6,262,206).

With regard to the limitations of claim 21, Nesvadba discloses that the polymers are useful for following applications: **adhesives**, detergents, dispersants, emulsifiers, surfactants, defoamers, adhesion promoters, corrosion inhibitors, viscosity improvers, lubricants, rheology modifiers, thickeners, crosslinkers, paper treatment, water treatment, electronic materials, **paints**, coatings, photography, ink materials, imaging materials, superabsorbants, **cosmetics**, hair products, preservatives, biocide materials

Art Unit: 1796

or modifiers for asphalt, leather, textiles, ceramics and wood (col. 12, line 60 through col. 13, line 3).

Nesvadba discloses that when mixtures of water and **water-soluble** or water-miscible organic liquids are selected as the **aqueous reaction media**, the water to cosolvent weight ratio is typically in the range of about 100:0 to about 10:90 (col. 10, lines 35-38).

Response to Arguments

7. Applicant's arguments filed on January 4, 2008 have been fully considered but they are not persuasive.

8. In response to Applicants arguments that "Applicant's unique COMBINATION of claim elements and limitations is not taught or suggested by the '206 reference"(the last two lines of page 2) and "the obviousness rejection in this case is a classic example of hindsight " (page 3, 2nd paragraph), it is noted the following.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Furthermore, Nesvadba discloses a polymerizable composition, comprising a) at least one ethylenically unsaturated monomer or oligomer, and b) an initiator compound of formula (I) which is substantially identical to claimed formulas (I) and (II), and a process for polymerizing ethylenically unsaturated monomers, novel initiator compounds and their use for polymerization, intermediate compounds and also the polymer or copolymer produced by this process (abstract).

9. In response to Applicants arguments that Applicant's invention relates to the field of amphiphilic gradient copolymers that are soluble in water as well as in organic solvents (the specification, page 1, lines 13-15), as it is recited in newly amended claim 1, and since the solubility of a copolymer in water and solvent was not recognized as a result to achieve in the '206 patent, the composition could not be optimized through routine experimentation to obtain such a result (page 3), it is noted that Nesvadba clearly discloses that the process may be carried out in the presence of an organic solvent or in the **presence of water** or in mixtures of organic solvents and water. Additional cosolvents or surfactants, such as glycols or ammonium salts of fatty acids, may be present (col. 9, lines 62-66). See also paragraph 6 of the current Office Action.

10. It appears that the focal point of Applicants argument resides in the contention that Nesvadba teaches away from Applicant's claimed combination, for example, there is no teaching or suggestion that a gradient polymerization requires less cycle time and produces a copolymer having excellent properties similar to the pure blocks of the '206 reference (page 4, 4th paragraph).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., less cycle time and produces a copolymer having excellent properties) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments, the recitation of gradient copolymers has been given little patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

11. It is worth to mention that Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teaching in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, **to fully consider the references in entirety as potentially teaching all or part of the claimed invention**, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Art Unit: 1796

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL M. BERNSHTEYN whose telephone number is (571)272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M. Bernshteyn/
Examiner, Art Unit 1796

/M. M. B./
Examiner, Art Unit 1796

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796